



1

M1653-8

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue

Application of : Niro Nakamichi, Makoto Hara, and Yasuhiro
Noguchi
Serial No. : 08/250,667
Filed : May 27, 1994
For : **DISK PLAYBACK DEVICE**
Reissue of
U.S. Patent No. : 5,123,001
Issued : June 16, 1992
Examiner :
Art Unit :

I hereby certify that this correspondence is being deposited with the United States Postal
Service as first class mail in an envelope addressed to: Commissioner of Patents and
Trademarks, Washington D.C. 20231 on;

Date

: 10/24/94

By

: GEORGE J. BRANDT, JR.

Signature

: *[Handwritten Signature]*

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Att: Office of Deputy Assistant Commissioner

for Patent Policy and Projects

Crystal Park 1, Suite 520

Sir:

REQUEST FOR RECONSIDERATION OF DECISION ON PETITION

Applicants request reconsideration of the decision mailed August 30,
1994 in the above application refusing status thereto under 37 C.F.R.
1.47(a). It is believed this request and the supporting documents submitted

with it establish that the application is entitled to such status and for the reasons detailed next.

1. The Takenami Declaration Exhibit I (letter to Mr. Hara) establishes that on September 27, 1994, a complete copy of the reissue application papers (specification including claims, drawings and declaration) was sent to inventor Makoto Hara at his last known mailing address. Exhibit I advised Mr. Hara of his right to be included in the application and invited him to join in the application.

2. The mailing to Mr. Hara was by registered mail (Takanami Declaration Exhibit II-Receipt of registered Mail).

3. Takenami Exhibit I requested Mr. Hara reply to Mr. Takenami not later than October 7, 1994.

4. Mr Takenami's Declaration states that as of October 17, 1994, Mr. Hara had not replied and Mr. Hara concluded that Mr. Hara still refuses to and will not join in the application.

5. The Saito Declaration provides an English translation of the information contained in Japanese in the letter sent Mr. Hara, and of the mail receipt supporting that the application papers were mailed to Mr. Hara.

6. It is believed the foregoing establishes that Mr. Hara continues to refuse joining in making this application and that the remaining applicants are in entitled to invoke and receive 37 C.F.R. status for this application.

7. A new declaration identifying the inventors as being joint and setting forth citizenship of all inventors is enclosed, this declaration having been executed by inventors Nakamichi and Noguchi.

Granting of the herein made Request and 37 C.F.R. 1.47(a) status of the application is solicited.

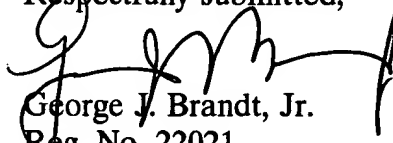
Enclosed with this Request are:

Declaration of Shingo Takenami with 2 attached Exhibits

Declaration of Mami Saito with 2 attached Exhibits

New Declaration of inventors Nakamichi and Noguchi.

Respectfully submitted,



George J. Brandt, Jr.

Reg. No. 22021

Attorney for Applicants

145 North Fifth Avenue
Mount Vernon, NY 10550
(914) 667-6755

ナカミチ株式会社

〒187 東京都小平市鈴木町1-153

1994年 9月27日

東京都国立市西 2-29-24

原 誠 様

ナカミチ株式会社

総務部 特許担当

竹 浪 真 吾



拝啓 時下ますますご盛昌のこととお慶び申し上げます。

さて、本年4月及び6月に、私は中道仁郎氏と野口康弘氏と共に貴方が発明者であるナカミチ株式会社の米国特許 第5,123,001号を、ナカミチ株式会社が再発行のため、米国に特許出願を行おうとしていることを伝えるため、電話し、またお宅に訪問しました。そこで私は貴方に再発行の出願のために宣誓書にサインをするようお願いしましたが、貴方は断りました。

再発行出願は、中道仁郎氏と野口康博氏によって出願されましたが、貴方は米国特許 第5,123,001号の一人の発明者であり、本出願に名前が挙げられるべき方です。

貴方は本出願に加えられる権限を有する方です（現時点で、また将来）。このため、米国特許庁に出願番号 第08/250,667号として1994年 5月27日に 出願された、完全な再発行出願書類（クレームを含む明細書、図面及び宣誓書）を同封します。

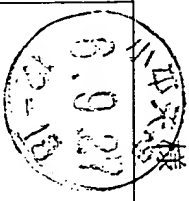
もし貴方がその後、考えを変え、再発行出願に参加するならば、先ず完全な再発行出願書類を検討し、貴方の名前、居所、国籍及び郵便宛先が示されている（最終頁）再発行出願宣誓書にサイン及び日付を記入することによってなされます。そして全ての書類をナカミチに返却下さい。

もし貴方が考えを変えず、本出願に参加することによりナカミチに協力することがないのであれば、本書類の“Refusal Note”の欄にチェックをし、貴方の名前を下記にサインしてナカミチ宛に書類を返送下さい。

何れの場合においても、来る10月 7日までに、同封の返信用封筒にてナカミチにお送り下さるよう、よろしくお願い申し上げます。

敬具

書留郵便物受領証

引 受 番 号	郵便料 円	中出損害 要償額 円	受取人の氏名	摘要
78370	740		原 誠	簡
(差出人の住所氏名) 東京都小平市鈴木町1丁目153番地 ナカミチ株式会社				
(ご注意) ●この受領証は、損害賠償の請求をするときその他の場合に必要です。大切に保管ください。 ●簡易書留の損害賠償額は、8千円を限度とする実損額です。			引 受 日 付 印	

ユ 07120 (1年保存)



1

M1653-8

UNITED STATES PATENT AND TRADEMARK OFFICE

#3

In re ReissueApplication of : Niro Nakamichi, Makoto Hara, and Yasuhiro
Noguchi**RECEIVED**

Serial No. : 08/250,667

NOV - 7 1994

Filed : May 27, 1994

For : **DISK PLAYBACK DEVICE****SPECIAL PROGRAMS OFFICE
A/C PATENTS**

Reissue of

U.S. Patent No. : 5,123,001

Issued : June 16, 1992

RECEIVED

Examiner :

OCT 31 1994

Art Unit :

**SPECIAL PROGRAMS OFFICE
A/C PATENTS**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Att: Office of Deputy Assistant Commissioner

for Patent Policy and Projects

Crystal Park 1, Suite 520

Sir:

DECLARATION OF SHINGO TAKENAMI

Shingo Takenami declares that:

1. I am the Manager of the patent section of Nakamichi Corporation and fully familiar with all proceedings had to date in connection with the filing of the above-identified reissue application.

2. In furtherance of having Makoto Hara, a named inventor who previously had refused to join in the application now join in the application, I sent a letter (copy annexed as Exhibit I) to Mr. Hara informing him of his

right to be included in the application and requesting he execute the application. Included with my letter was a complete copy of the application, this complete copy including specification with claims, drawings and an inventors declaration. My letter requested Mr. Hara join or express his refusal not to join the application by October 7, 1994. ✓

3. The letter and complete copy of the above application was mailed to Mr. Hara at his last known address, viz., 29-24, Nishi 2-chome, Kunitachi-shi, Tokyo, Japan. The mailing was made by registered mail dispatched on September 27, 1994. A copy of the registered mail receipt is attached as Exhibit II. ✓

4. As of this date, I have received no response from Mr. Hara and, therefore, conclude that he still refuses to join in the application.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.



Shingo Takenami

Dated: October 17, 1994



1 of 13

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue

Application of : Niro Nakamichi, Makoto Hara, and Yasuhiro
Noguchi
Serial No. : 08/250,667
Filed : May 27, 1994
For : **DISK PLAYBACK DEVICE**
Reissue of
U.S. Patent No. : 5,123,001
Issued : June 16, 1992
Examiner :
Art Unit :

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Att: Office of Deputy Assistant Commissioner

for Patent Policy and Projects

Crystal Park 1, Suite 520

Sir:

REISSUE APPLICATION DECLARATION

We, Niro NAKAMICHI and Yasuhiro NOGUCHI as joint inventors along with Makoto HARA, who heretofore refused to join in this application for a reissue of patent number 5,123,001 and whose last known address is 29-24, Nishi 2-chome, Kunitachi-shi, Tokyo, Japan, do individually and on behalf of Makoto HARA (if he does not now and here join) declare that:

Our residences, Post Office addresses and citizenships are stated below next to our respective names.

We believe we are the original, first and joint inventors of the subject matter which is described and claimed in patent number 5,123,001, granted June 16, 1992, and for which a reissue patent is sought on the invention entitled **Disk Playback Device**, the specification of which was filed on May 27, 1994 as Application Serial Number 08/250,667.

We hereby state that we have reviewed and understand the contents of the above identified specification, including the claims.

We acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, section 1.56(a).

We hereby claim foreign priority benefits under Title 35, United States Code Sec. 119 of the foreign application(s) for patent or inventor's certificate listed below, as claimed in the original patent, and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed.

NATIONAL PROCESSING PROVISIONS

Prior Foreign Application(s)			Priority Claimed
(Number)	(Country)	(Day/Month/Year Filed)	
1-219071	Japan	26/8/89	Yes
1-219072	Japan	26/8/89	Yes
1-219073	Japan	26/8/89	Yes

We verily believe that the original patent is partly inoperative due to the claims claiming less than patentees had a right to claim in the patent. This belief is based upon the reasons set forth below.

During the prosecution of the patent, errors occurred which resulted in the issued patent failing to claim the full scope of the invention. These errors arose due to communication difficulties between the prosecuting

attorneys and the applicants because of language differences, their respective languages being English and Japanese, in that the breadth of the invention was not completely appreciated before the patent issued. Subsequent to the issuance of the patent, the applicants further studied the issued patent and discovered that the English language claims included limitations upon their invention that were not required by law for the claims in question to be valid in view of the prior art. The limitations that are the product of the above cited errors are set forth below.

Independent claims 1, 2, and 8, include straight line path limitations upon first and second disk conveying means which are unnecessarily restrictive. The functioning of first and second disk conveying means, in a common plane, and in conjunction with the means for displacing the magazine is sufficient to distinguish the invention over the prior art. The single plane transport effects an efficiency of operation in the claimed device in transporting disks between a concentric storage magazine, a disk reader, and a location for inserting the disks into the mechanism, which is neither found nor suggested in the prior art device nor combinations thereof. The planar nature of the transport mechanism is clearly illustrated in Figs. 2, 7, 8, and 9 of the original patent.

Independent claims 1 and 8 recite the further limitation of moving disks from outside the disk storage and playback device to a position therein. This limitation is unnecessarily limiting because the subject matter of the claims is patentable without the limitation that an access position, from which disks are loaded into the read position, be outside the chassis of the disk player. Combinations of limitations exist, without the external location requirement, which are not found nor suggested in the prior art. Such combinations include the limitation of transporting a disk, originating outside the disk player, from an access position to a disk reading position, and either planar transport or control means for loading the magazine via the access position.

Independent claims 1, 2 and 8 recite the limitation of means for displacing the magazine. This limitation unnecessarily limits the scope of the claims in view of the prior art. A limitation that the magazine be selectively alignable with the first disk conveying means, claimed in combination with planar transport, external loading and unloading of the magazine, and/or other structural limitations as discussed below, provide combinations of features not found in the prior art.

Independent claims 1, 2, 5, 7 and 8 recite transporting disks to a first position which is a disk-reading position whereat a disk reader is adapted to read a disk. This limitation unnecessarily limits the claimed scope of the invention. A limitation that the first position be aligned with the disk reader, or a turntable thereof, in combination with limitations including straight line transport, external loading and unloading of the magazine, and other structural limitations is sufficient to distinguish the claims from the prior art.

Independent claims 5 and 7 recite elements including a mainframe and subframes. These elements are not required for patentability in claims having subject matter directed to combinations of planar transport, straight line transport, external loading of the magazine, and other structural limitations sufficient to distinguish the claims from the prior art.

In order to correct the error that applicants have claimed less than they are entitled to claim, new independent claims 10 through 24 have been added. The subject matter of the new claims comprises combinations of features that were not heretofore presented. These features include a transport means for transporting the disks in a plane parallel to a surface of the disks, the orthogonal orientation of the plane of transport with respect to the alignment direction of the storage means, external loading of the magazine, subframes, mainframe frame transport to an access position, straight line transport to a first position aligned with a disk reader or turntable, and magazine alignment with a transport mechanism. The

differences between the new claims and the issued claims, and the distinguishing subject matter of the new claims, are set forth below.

2 New claim 10 claims the present invention having limitations including a transport means functioning along a substantially planar path in a plane parallel to a surface of the disks. The claim differs from the original claims in ^{does not} that it requires a path of transport beginning outside the disk storage and playback device nor that the transport path be linear.

New claim 11 claims the present invention having limitations including a transport means functioning along a substantially planar path in a plane parallel to a surface of the disks and orthogonal to a direction of alignment of a storage means. This claim differs from the original claims in that it is not unnecessarily restricted by recitation of a path of transport beginning outside the disk storage and playback device, the transport path being linear, or a nondetachable storage means.

New claim 12 claims the present invention having limitations including a transport means functioning between a storage means and a read position, along a substantially planar path in a single plane parallel to a surface of the disks, and an ejection means for ejecting disks from the storage means through an access aperture for ejecting and loading. The claim differs from the claims in the original patent in that it does not include a path beginning outside the disk storage and playback device nor that the transport path be linear.

New claim 13 claims the present invention having limitations including a transport means functioning between a storage means and a read position, along a substantially planar path in a single plane parallel to a surface of the disks, and an ejection means for ejecting disks from the read position through an access aperture for ejecting and loading. The claim differs from the claims in the original patent in that it does not include a path beginning outside the disk storage and playback device, or the transport path being linear.

New claim 14 claims the present invention having limitations including a transport means functioning between a storage means and a read position, along a substantially planar path in a single plane parallel to a surface of the disks, and an ejection means for ejecting disks from the storage means through an access aperture to an exposed position while the storage means remain unexposed. The claim differs from the claims in the original patent in that it does not include a path beginning outside the disk storage and playback device or the transport path being linear.

New claim 15 claims the present invention having limitations including a transport means functioning substantially in a plane defined by a selected position of a storage means, a read position, and an access aperture; and an access aperture permitting external access for loading and unloading of disks to and from the transport means. The claim differs from the claims in the original patent in that it does not include the transport path being linear, but does require that the transport path be within the plane of the selected storage position, the read position, and the access aperture.

New claim 16 claims the present invention having limitations including a transport means functioning substantially in a transport plane defined by two substantially linear paths of the transport means. Disks are transported along a first path between a storage means and an access position. Disks are also transported along a second path between the access position and a read position. The claim further recites the access position permitting loading and unloading of disks in conjunction with the transport means. The claim differs from the claims in the original patent in that it recites linear paths not claimed heretofore, and it does not require that the access position be outside the chassis of the device for storing and playing disks.

New claim 17 claims the present invention having limitations including a transport means functioning substantially in a transport plane

defined by two substantially linear paths of the transport means. Disks are transported along a first path between a storage means and an access position, and along a second path between the storage means and a read position. The claim further recites the access aperture permitting loading and unloading of disks to and from the transport means. The claim differs from the claims in the original patent in that it recites linear paths not claimed heretofore, and does not require that the access position be outside the chassis of the device for storing and playing disks.

New claim 18 claims the present invention having limitations including the transport means functioning substantially in a transport plane defined by two substantially linear paths of the transport means. Disks are transported along a first path between a read position and an access position, and along a second path between the read position and a storage means. The claim further recites the access aperture permitting loading and unloading of disks. The claim differs from the claims in the original patent in that it does not require that the access position be outside the chassis of the device for storing and playing disks.

New claim 19 claims the present invention having limitations including the transport means functioning along a substantially linear path in a plane parallel to a surface of the disks but does not require that a path of transport begin outside the disk storage and playback device.

New claim 20 claims the present invention having limitations including the first and second disk transport means functioning substantially along first and second straight line paths. Disks are transported along a first straight line path between a magazine and a mainframe at a first position in alignment with a disk reader. Disks are further transported in a mainframe along a second straight line path between the first position and an access position. The disk reader includes means for reading a disk at the first position. Means are also provided for aligning the magazine and the first transport means. The claim further recites control means

permitting loading and unloading of the magazine with disks via the access position. The claim differs from the claims in the original patent in that it does not require subframes, an access position outside the chassis of the device for storing and playing disks, or a first position location at a read position.

New claim 21 claims the present invention having limitations including the first and second disk transport means functioning substantially along first and second straight line paths. Disks are transported along a first straight line path between a magazine and a mainframe at a first position in alignment with a disk reader. Disks are further transported in a mainframe along a second straight line path between the first position and an access position. Means are provided for displacing disks from the first position to the read position. Means are also provided for aligning the magazine and the first transport means. The claim further recites control means permitting loading and unloading of the magazine via the access position. The claim differs from the claims in the original patent in that it does not require subframes, an access position outside the chassis of the device for storing and playing disks, or a first position location at a read position.

New claim 22 claims the present invention having limitations including the first and second disk transport means functioning to transport disks between a magazine, a mainframe at a first position in alignment with a disk reader, and an access position. Disks are transported on subframes between the magazine and the first position. The mainframe carries a selected subframe and disk between the first position and the access position. Means are provided for displacing disks from the first position to a turntable of the disk reader. The claim further recites control means permitting loading and unloading of the magazine via the access position. The claim differs from the claims in the original patent in that it does not require an access position outside the chassis of the device for storing and

playing disks, a first position location at a read position, or straight line transport.

New claim 23 claims the present invention having limitations including the first and second disk transport means functioning to transport disks between a magazine, a first position in alignment with a disk reader, and an access position. The first transport means transports disks on subframes between the magazine and the first position. The second transport means carries a selected subframe and disk between the first position and the access position. Means are provided for displacing disks from the first position to a turntable of the disk reader. Means are also provided for aligning the magazine and the first transport means. The claim further recites control means permitting loading and unloading of the magazine via the access position. The claim differs from the claims in the original patent in that it does not require an access position outside the chassis of the device for storing and playing disks, a first position location at a read position, a mainframe, or straight line transport.

New claim 24 claims the present invention having limitations including the first and second disk transport means functioning to transport disks between a magazine, a first position in alignment with a turntable of a disk reader, and an access position. The first transport means transports disks between the magazine and the first position. The second transport means transports disks between the first position and the access position. The disk reader includes means for reading disks at the first position to a turntable of the disk reader. Means are also provided for aligning the magazine and the first transport means. The claim further recites control means permitting loading and unloading of the magazine via the access position. The claim differs from the claims in the original patent in that it does not require an access position outside the chassis of the device for storing and playing disks, a first position location at a read position, a mainframe, subframes, or straight line transport.

New claim 25 claims the present invention having limitations including a disk transport means functioning to transport a subframe carrying a disks between a magazine and an access position. Means are also provided for aligning the magazine and the first transport means. The claim further recites control means for controlling the transport means to permit loading and unloading of the magazine via the access position without reading the disk. The claim differs from the claims in the original patent in that it does not require an access position outside the chassis of the device for storing and playing disks, a first position location at a read position, or straight line transport.

New claim 26 claims the present invention having limitations including a mainframe for carrying a subframe holding a disk, mainframe transport means functioning to transport the mainframe between a position where the mainframe accepts a subframe and an access position for loading and unloading. Means are also provided for transporting subframes between the magazine and the mainframe. The claim further recites control means permitting loading and unloading of the magazine via the access position without reading the disk. The claim differs from the claims in the original patent in that it does not require an access position outside the chassis of the device for storing and playing disks, a first position location at a read position, transferring subframes to the mainframe at the first position, or straight line transport.

Issued claim 7 has been amended to correct for improper antecedent basis for "said mainframe" in lines 19-20. Additionally, claim 7 has been amended to correct for a typographical error in line 9 to avoid redundant claiming of "subframes."

We declare that the above referenced error(s) arose without any deceptive intention. ✓

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief

are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Inventor's full name: Niro NAKAMICHI
Residence: Tokyo, JAPAN
Address: No. 153, Suzukicho 1-chome
Kodaira-shi, Tokyo, Japan
Citizenship: Japan ✓

N. Nakami
(signature)

September 29, 1994
(date)

Inventor's full name: Yasuhiro NOGUCHI
Residence: Tokyo, JAPAN
Address: No. 153, Suzukicho 1-chome
Kodaira-shi, Tokyo, Japan
Citizenship: Japan ✓

Y. Noguchi
(signature)

September 28, 1994
(date)

Inventor's full name: Makoto Hara
Residence: Tokyo, JAPAN
Address: 29-24, Nishi 2-chome
Kunitachi-shi, Tokyo, Japan
Citizenship: Japan



(signature)

(date)



1

M1653-8

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue

Application of : Niro Nakamichi, Makoto Hara, and Yasuhiro
Noguchi

Serial No. : 08/250,667

Filed : May 27, 1994

For : **DISK PLAYBACK DEVICE**

Reissue of

U.S. Patent No. : 5,123,001

Issued : June 16, 1992

Examiner :

Art Unit :

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Att: Office of Deputy Assistant Commissioner

for Patent Policy and Projects

Crystal Park 1, Suite 520

Sir:

DECLARATION OF MAMI SAITO

Mami Saito declares that:

1. I am fluent in both the Japanese and English languages.
2. I have translated from Japanese to English, the texts identified as Exhibits I and II attached to a declaration of Shingo Takenami being filed in support of a Request for Reconsideration of Petition Decision made in the above application. My translations are attached hereto, each having a copy of the corresponding Takenami exhibit appended.

3. I certify that my translations are each accurate English texts of the Japanese contained in the Takenami declaration exhibits.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.


Mami Saito

Dated: 10/21/94

NAKAMICHI
Nakamichi Corporation
1-153, Suzukicho
Kodaira, Tokyo 187

September 27, 1994

Mr. Makoto Hara
2-29-24, Nishi
Kunitachi-Shi Tokyo

Shingo Takanami
Patent Section
Nakamichi Corporation

I called and visited you this April and June to inform you that Nakamichi Corporation was trying to file an application in the United States for reissue of Nakamichi's U.S. Patent No. 5,123,001; you are one of the named inventors along with Mr. Niro Nakamichi and Mr. Yasuhiro Noguchi. I requested that you sign a declaration in order to reissue the patent, but you refused.

The reissue application was filed by Mr. Niro Nakamichi and Mr. Yasuhiro Noguchi. However, you are one of the inventors of US Patent No. 5,123,001 and your name should be part of this application.

You are entitled to have your name included in this application (presently and also in the future). For that purpose, I am enclosing the complete Reissue Application papers (the application including claims, the drawings, and the declaration) which was filed on May 27, 1994 in the United States Patent and Trademark Office as Serial No. 08/250,667.

If you change your mind later and join in the reissue application, this can be done by first reviewing the complete reissue application papers and executing the Reissue Application Declaration by signing and dating same where your name, residence, citizenship, and address are shown (last page). Then please return all the papers to Nakamichi.

If you do not change your mind and do not cooperate with Nakamichi by joining in the application, please place a check next to the "Refusal Note" in the papers, sign your name below and return the papers to Nakamichi.

In either case, please return the papers to Nakamichi in the envelop provided for that purpose by October, 7. Thank you.

ナカミチ株式会社

〒187 東京都小平市鈴屋町1-153

1994年 9月27日

東京都国立市西 2-29-24

原 誠 様

ナカミチ株式会社

総務部 特許担当

竹 浪 真 吾



拝啓 時下ますますご盛昌のこととお慶び申し上げます。

さて、本年4月及び6月に、私は中道仁郎氏と野口康弘氏と共に貴方が発明者であるナカミチ株式会社の米国特許 第5,123,001号を、ナカミチ株式会社が再発行のため、米国に特許出願を行おうとしていることを伝えるため、電話し、またお宅に訪問しました。そこで私は貴方に再発行の出願のために宣誓書にサインをするようお願いしましたが、貴方は断りました。

再発行出願は、中道仁郎氏と野口康博氏によって出願されましたが、貴方は米国特許 第5,123,001号の一人の発明者であり、本出願に名前が挙げられるべき方です。

貴方は本出願に加えられる権限を有する方です（現時点で、また将来）。このため、米国特許庁に出願番号 第08/250,667号として1994年 5月27日に
出願された、完全な再発行出願書類（クレームを含む明細書、図面及び宣誓書）を同封します。

もし貴方がその後、考えを変え、再発行出願に参加するならば、先ず完全な再発行出願書類を検討し、貴方の名前、居所、国籍及び郵便宛先が示されている（最終頁）再発行出願宣誓書にサイン及び日付を記入することによってなされます。そして全ての書類をナカミチに返却下さい。

もし貴方が考えを変えず、本出願に参加することによりナカミチに協力することがないのであれば、本書類の“Refusal Note”の欄にチェックをし、貴方の名前を下記にサインしてナカミチ宛に書類を返送下さい。

何れの場合においても、来る10月 7日までに、同封の返信用封筒にてナカミチにお送り下さるよう、よろしくお願い申し上げます。

敬具

EXHIBIT II

RECEIPT OF REGISTERED MAIL

NAME OF RECEIVER

POSTAGE

書留郵便物受領証

引受番号	郵便料	申出損害要領額	受取人の氏名	摘要
7A 370	740		原 誠	簡

SHIPPER'S ADDRESS AND NAME

1-153, 1-chome
SUZUKI-CHO
KODAIRA-SHI, TOKYO
NAKAMICHI CORPORATION

東京都小平市鈴木町1丁目153番地

ナカミチ株式会社

引受日付印

0.0 07

02-19

STAMP OF ACCEPTANCE DATE AND PLACE

KODAIRA TGNJIN
SEPT. 27, 1994
12 PM TO 6 PM

ACCEITANCE #

エ 07120 (1年保存)

(受取人の住所氏名)

(ご注意)
●この受領証は、損害賠償の請求をするときその他の場合に必要ですから、大切に保管ください。
●簡易書留の損害賠償額は、8千円を限度とする実損額です。



書留郵便物受領証

引 受 番 号	郵 便 料 円	中出損害 要 償 額 円	受 取 入 の 氏 名	備 考
78370	740		原 誠	簡

(差出人の住所氏名)
東京都小平市鈴木町1丁目153番地
ナカミチ株式会社

(ご注意)
●この受領証は、損害賠償の請求をするときその他の場合に必要ですから、大切に保管ください。
●簡易書留の損害賠償額は、8千円を限度とする実損額です。

引 受 日 付 印

ユ 07120 (1年保存)

1 of 13

**REISSUE APPLICATION DECLARATION
AND POWER OF ATTORNEY**

ATTORNEY'S DOCKET NO. M1653-8

We, Niro NAKAMICHI and Yasuhiro NOGUCHI as joint inventors along with Makoto HARA, who refuses to join in this application for a reissue of patent number 5,123,001 and whose last known address is 29-24, Nishi 2-chome, Kunitachi-shi, Tokyo, Japan, do individually and on behalf of Makoto HARA declare that:

*citizenship
of Hara X*

Our residences, Post Office addresses and citizenships are stated below next to our respective names.

We believe we are the original, first and sole inventors of the subject matter which is described and claimed in patent number 5,123,001, granted June 16, 1992, and for which a reissue patent is sought on the invention entitled **Disk Playback Device**, the specification of which is

X

(X) attached hereto,

() was filed on as Application Serial Number and

() was amended on (if applicable).

We hereby state that we have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

✓

We acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, section 1.56(a).

✓

2 of 13

We hereby claim foreign priority benefits under Title 35, United States Code Sec. 119 of the foreign application(s) for patent or inventor's certificate listed below, as claimed in the original patent, and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed.

NATIONAL PROCESSING PROVISIONS

Prior Foreign Application(s) (Number)	(Country)	(Day/Month/Year Filed)	Priority Claimed
1-219071	Japan	26/8/89	Yes
1-219072	Japan	26/8/89	Yes
1-219073	Japan	26/8/89	Yes

We verily believe that the original patent is partly inoperative due to the claims claiming less than patentees had a right to claim in the patent. This belief is based upon the reasons set forth below.

During the prosecution of the patent, errors occurred which resulted in the issued patent failing to claim the full scope of the invention. These errors arose due to communication difficulties between the prosecuting attorneys and the applicants because of language differences, their respective languages being English and Japanese, in that the breadth of the invention was not completely appreciated before the patent issued. Subsequent to the issuance of the patent, the applicants further studied the issued patent and discovered that the English language claims included limitations upon their invention that were not required by law for the claims in question to be valid in view of the prior art. The limitations that are the product of the above cited errors are set forth below.

3 of 13

M1653-8

Independent claims 1, 2, and 8, include straight line path limitations upon first and second disk conveying means which are unnecessarily restrictive. The functioning of first and second disk conveying means, in a common plane, and in conjunction with the means for displacing the magazine is sufficient to distinguish the invention over the prior art. The single plane transport effects an efficiency of operation in the claimed device in transporting disks between a concentric storage magazine, a disk reader, and a location for inserting the disks into the mechanism, which is neither found nor suggested in the prior art device nor combinations thereof. The planar nature of the transport mechanism is clearly illustrated in Figs. 2, 7, 8, and 9 of the original patent.

Independent claims 1 and 8 recite the further limitation of moving disks from outside the disk storage and playback device to a position therein. This limitation is unnecessarily limiting because the subject matter of the claims is patentable without the limitation that an access position, from which disks are loaded into the read position, be outside the chassis of the disk player. Combinations of limitations exist, without the external location requirement, which are not found nor suggested in the prior art. Such combinations include the limitation of transporting a disk, originating outside the disk player, from an access position to a disk reading position, and either planar transport or control means for loading the magazine via the access position.

Independent claims 1, 2 and 8 recite the limitation of means for displacing the magazine. This limitation unnecessarily limits the scope of the claims in view of the prior art. A limitation that the magazine be selectively alignable with the first disk conveying means, claimed in combination with planar transport, external loading and unloading of the

4 of 13

M1653-8

magazine, and/or other structural limitations as discussed below, provide combinations of features not found in the prior art.

Independent claims 1, 2, 5, 7 and 8 recite transporting disks to a first position which is a disk-reading position whereat a disk reader is adapted to read a disk. This limitation unnecessarily limits the claimed scope of the invention. A limitation that the first position be aligned with the disk reader, or a turntable thereof, in combination with limitations including straight line transport, external loading and unloading of the magazine, and other structural limitations is sufficient to distinguish the claims from the prior art.

Independent claims 5 and 7 recite elements including a mainframe and subframes. These elements are not required for patentability in claims having subject matter directed to combinations of planar transport, straight line transport, external loading of the magazine, and other structural limitations sufficient to distinguish the claims from the prior art.

In order to correct the error that applicants have claimed less than they are entitled to claim, new independent claims 10 through 24 have been added. The subject matter of the new claims comprises combinations of features that were not heretofore presented. These features include a transport means for transporting the disks in a plane parallel to a surface of the disks, the orthogonal orientation of the plane of transport with respect to the alignment direction of the storage means, external loading of the magazine, subframes, mainframe frame transport to an access position, straight line transport to a first position aligned with a disk reader or turntable, and magazine alignment with a transport mechanism. The

5 of 13

M1653-8

differences between the new claims and the issued claims, and the distinguishing subject matter of the new claims, are set forth below.

2 New claim 10 claims the present invention having limitations including a transport means functioning along a substantially planar path in a plane parallel to a surface of the disks. The claim differs from the original claims in that it requires a path of transport beginning outside the disk storage and playback device nor that the transport path be linear.

New claim 11 claims the present invention having limitations including a transport means functioning along a substantially planar path in a plane parallel to a surface of the disks and orthogonal to a direction of alignment of a storage means. This claim differs from the original claims in that it is not unnecessarily restricted by recitation of a path of transport beginning outside the disk storage and playback device, the transport path being linear, or a nondetachable storage means.

New claim 12 claims the present invention having limitations including a transport means functioning between a storage means and a read position, along a substantially planar path in a single plane parallel to a surface of the disks, and an ejection means for ejecting disks from the storage means through an access aperture for ejecting and loading. The claim differs from the claims in the original patent in that it does not include a path beginning outside the disk storage and playback device nor that the transport path be linear.

New claim 13 claims the present invention having limitations including a transport means functioning between a storage means and a read position, along a substantially planar path in a single plane parallel to a surface of the disks, and an ejection means for ejecting disks from the

6 of 13

M1653-8

read position through an access aperture for ejecting and loading. The claim differs from the claims in the original patent in that it does not include a path beginning outside the disk storage and playback device, or the transport path being linear.

New claim 14 claims the present invention having limitations including a transport means functioning between a storage means and a read position, along a substantially planar path in a single plane parallel to a surface of the disks, and an ejection means for ejecting disks from the storage means through an access aperture to an exposed position while the storage means remain unexposed. The claim differs from the claims in the original patent in that it does not include a path beginning outside the disk storage and playback device or the transport path being linear.

New claim 15 claims the present invention having limitations including a transport means functioning substantially in a plane defined by a selected position of a storage means, a read position, and an access aperture; and an access aperture permitting external access for loading and unloading of disks to and from the transport means. The claim differs from the claims in the original patent in that it does not include the transport path being linear, but does require that the transport path be within the plane of the selected storage position, the read position, and the access aperture.

New claim 16 claims the present invention having limitations including a transport means functioning substantially in a transport plane defined by two substantially linear paths of the transport means. Disks are transported along a first path between a storage means and an access position. Disks are also transported along a second path between the access position and a read position. The claim further recites the access

7 of 13

M1653-8

position permitting loading and unloading of disks in conjunction with the transport means. The claim differs from the claims in the original patent in that it recites linear paths not claimed heretofore, and it does not require that the access position be outside the chassis of the device for storing and playing disks.

New claim 17 claims the present invention having limitations including a transport means functioning substantially in a transport plane defined by two substantially linear paths of the transport means. Disks are transported along a first path between a storage means and an access position, and along a second path between the storage means and a read position. The claim further recites the access aperture permitting loading and unloading of disks to and from the transport means. The claim differs from the claims in the original patent in that it recites linear paths not claimed heretofore, and does not require that the access position be outside the chassis of the device for storing and playing disks.

New claim 18 claims the present invention having limitations including the transport means functioning substantially in a transport plane defined by two substantially linear paths of the transport means. Disks are transported along a first path between a read position and an access position, and along a second path between the read position and a storage means. The claim further recites the access aperture permitting loading and unloading of disks. The claim differs from the claims in the original patent in that it does not require that the access position be outside the chassis of the device for storing and playing disks.

New claim 19 claims the present invention having limitations including the transport means functioning along a substantially linear path

8 of 13

M1653-8

in a plane parallel to a surface of the disks but does not require that a path of transport begin outside the disk storage and playback device.

New claim 20 claims the present invention having limitations including the first and second disk transport means functioning substantially along first and second straight line paths. Disks are transported along a first straight line path between a magazine and a mainframe at a first position in alignment with a disk reader. Disks are further transported in a mainframe along a second straight line path between the first position and an access position. The disk reader includes means for reading a disk at the first position. Means are also provided for aligning the magazine and the first transport means. The claim further recites control means permitting loading and unloading of the magazine with disks via the access position. The claim differs from the claims in the original patent in that it does not require subframes, an access position outside the chassis of the device for storing and playing disks, or a first position location at a read position.

New claim 21 claims the present invention having limitations including the first and second disk transport means functioning substantially along first and second straight line paths. Disks are transported along a first straight line path between a magazine and a mainframe at a first position in alignment with a disk reader. Disks are further transported in a mainframe along a second straight line path between the first position and an access position. Means are provided for displacing disks from the first position to the read position. Means are also provided for aligning the magazine and the first transport means. The claim further recites control means permitting loading and unloading of the magazine via the access position. The claim differs from the claims in the original patent in that it does not require subframes, an access position outside the chassis of the

9 of 13

M1653-8

device for storing and playing disks, or a first position location at a read position.

New claim 22 claims the present invention having limitations including the first and second disk transport means functioning to transport disks between a magazine, a mainframe at a first position in alignment with a disk reader, and an access position. Disks are transported on subframes between the magazine and the first position. The mainframe carries a selected subframe and disk between the first position and the access position. Means are provided for displacing disks from the first position to a turntable of the disk reader. The claim further recites control means permitting loading and unloading of the magazine via the access position. The claim differs from the claims in the original patent in that it does not require an access position outside the chassis of the device for storing and playing disks, a first position location at a read position, or straight line transport.

New claim 23 claims the present invention having limitations including the first and second disk transport means functioning to transport disks between a magazine, a first position in alignment with a disk reader, and an access position. The first transport means transports disks on subframes between the magazine and the first position. The second transport means carries a selected subframe and disk between the first position and the access position. Means are provided for displacing disks from the first position to a turntable of the disk reader. Means are also provided for aligning the magazine and the first transport means. The claim further recites control means permitting loading and unloading of the magazine via the access position. The claim differs from the claims in the original patent in that it does not require an access position outside the

10 of 13

M1653-8

chassis of the device for storing and playing disks, a first position location at a read position, a mainframe, or straight line transport.

New claim 24 claims the present invention having limitations including the first and second disk transport means functioning to transport disks between a magazine, a first position in alignment with a turntable of a disk reader, and an access position. The first transport means transports disks between the magazine and the first position. The second transport means transports disks between the first position and the access position. The disk reader includes means for reading disks at the first position to a turntable of the disk reader. Means are also provided for aligning the magazine and the first transport means. The claim further recites control means permitting loading and unloading of the magazine via the access position. The claim differs from the claims in the original patent in that it does not require an access position outside the chassis of the device for storing and playing disks, a first position location at a read position, a mainframe, subframes, or straight line transport.

New claim 25 claims the present invention having limitations including a disk transport means functioning to transport a subframe carrying a disks between a magazine and an access position. Means are also provided for aligning the magazine and the first transport means. The claim further recites control means for controlling the transport means to permit loading and unloading of the magazine via the access position without reading the disk. The claim differs from the claims in the original patent in that it does not require an access position outside the chassis of the device for storing and playing disks, a first position location at a read position, or straight line transport.

11 of 13

M1653-8

New claim 26 claims the present invention having limitations including a mainframe for carrying a subframe holding a disk, mainframe transport means functioning to transport the mainframe between a position where the mainframe accepts a subframe and an access position for loading and unloading. Means are also provided for transporting subframes between the magazine and the mainframe. The claim further recites control means permitting loading and unloading of the magazine via the access position without reading the disk. The claim differs from the claims in the original patent in that it does not require an access position outside the chassis of the device for storing and playing disks, a first position location at a read position, transferring subframes to the mainframe at the first position, or straight line transport.

Issued claim 7 has been amended to correct for improper antecedent basis for "said mainframe" in lines 19-20. Additionally, claim 7 has been amended to correct for a typographical error in line 9 to avoid redundant claiming of "subframes."

We declare that the above referenced error(s) arose without any deceptive intention.

Power of Attorney: As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:

Thomas R. Morrison, Esq.
Roger S. Thompson, Esq.
George J. Brandt, Jr., Esq.
Harold L. Burstyn, Esq.
Paul J. Lerner, Esq.
Herbert F. Ruschmann, Esq.
Scott D. Watkins, Esq.

Registration No: ~~27,361~~
Registration No: ~~29,594~~
Registration No: ~~22,021~~
Registration No: ~~33,658~~
Registration No: ~~27,654~~
Registration No: ~~35,341~~
Registration No: 36,715

12 of 13

M1653-8

Vineet Kohli, Esq.
Lawrence I. Wechsler, Esq.
Christopher R. Pastel, Esq.
Peter J. Gluck, Esq.

Registration No: 37,003
Registration No: 36,049
Registration No: P-37,694
Registration No: P-38,022.

Send Correspondence To:

Direct Telephone Calls To:

Thomas R. Morrison, Esq.
MORRISON LAW FIRM
145 North Fifth Ave.
Mount Vernon, NY 10550

Thomas R. Morrison, Esq.
(914) 667-6755

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Inventor's full name: Niro NAKAMICHI
Residence: Tokyo, JAPAN JP
Address: No. 153, Suzukicho 1-chome
Kodaira-shi, Tokyo, Japan
Citizenship: Japan

N. Nakamichi
(signature)

May 16, 1994
(date)

13 of 13

M1653-8

Inventor's full name: ³⁰⁰Yasuhiro NOGUCHI
Residence: Tokyo, JAPAN
Address: No. 153, Suzukicho 1-chome
Kodaira-shi, Tokyo, Japan
Citizenship: Japan

Y. Noguchi
(signature)

May 13, 1994
(date)